

#### REMARKS

At page 2 of the Official Action of September 3, 2003, claims 1-19 were rejected under 35 U.S.C. 112, second paragraph on the ground the expression "satisfactory developer performance" appearing in the independent claims is indefinite. This ground of rejection is courteously traversed.

It is well established law that Applicants are permitted substantial latitude in selecting claim language to the extent of even becoming their own lexicographers by adopting and using terms or expressions in their claims that are defined in the specification. In so doing, the intended meaning of such terms and expressions appearing in the claims need to be set-forth in the specification with sufficient information so that persons of ordinary skill in the art, in this case --photo-imaging--, could determine with reasonable certainty if there is an infringement.

Applicant submits, the expression "satisfactory developer performance" has been sufficiently defined in the specification as to enable one of ordinary skill in the art determine if there is an infringement.

In this regard, an **affidavit under Rule 132 of the inventor, Laszlo Papai**, is enclosed herewith showing how the information provided in the specification relative to the coined expression "satisfactory developer performance" enables one of ordinary skill in the art to measure on a comparative basis the density, color and contrast of developed color negatives, and thereby determine if there is an infringement. This is the ultimate test for definiteness.

The Papai Affidavit under Rule 132 with documentary supporting evidence demonstrates the expression as described in the captioned application denotes a widely known and practiced method, "Process C-41", for measuring the performance of photographic processing solutions, such as developers. The Affidavit concludes that because

the coined expression "satisfactory developer performance" is capable of being quantified or measured, the expression and its intended meaning meet the statutory requirement for **definiteness** under the second paragraph of 35 U.S.C. 112.

In view of the Affidavit and supporting **EXHIBIT**, reconsideration and withdrawal of the rejection under Section 112, are courteously requested.

At page 3 of the Official Action, claims 1-2, 5, 7, 11, 16 and 18-19 were rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto et al. This ground of rejection is courteously traversed as it applies to the claims now presented for re-examination.

The compositions of Hashimoto et al are prepared for use in the form of concentrated low viscosity slurries. They are called slurries, and not solutions because at least one of the active photographic processing compounds is dispersed in a medium in particulate form. Hashimoto et al employ as principal ingredient a water soluble polymer to achieve the desired flow properties for their photographic slurry concentrates to minimize the residue remaining in the container when filling a photo-processor. Hashimoto et al identify at Col. 2, lines 40-42 typical water soluble polymers for their slurries as selected from cellulosic resin, polyvinyl alcohol, polyvinyl pyrrolidone, acrylic resin and polystyrene sulfonate. Representative examples of these various classes of useful polymers are disclosed beginning at column 3.

Hashimoto et al developed their polymer-containing slurries with dispersed particles in an effort to solve the problems associated with high viscosity paste-form concentrates which the patentees describe as having to be extruded from their containers into a photographic processor using a special tool. Hashimoto et al found their slurry concentrates, when prepared with water soluble polymer, have enhanced flow properties with low viscosity at low

shear rate, which could be more readily transferred from their storage containers into photographic processors where the contents were then dissolved to make working strength solutions.

As an important distinction, Applicant's solutions are one-part concentrates, and not dispersions, or slurry concentrates like those of Hashimoto et al. Applicant is not concerned with solid residues remaining in their containers because the concentrates are solutions.

According to Col. 3, lines 29-40, the slurry concentrates of Hashimoto et al contain the polymer additive in an amount ranging from 0.1 to 10 percent-by-weight. Hashimoto et al expressly teach that with less than 0.1% polymer present a substantial amount of sediment occurs, whereas with more than 10% water soluble polymer present photographic quality deteriorates.

Hence, the major thrust of Hashimoto et al's invention resides in the preparation of slurry concentrates. At no time do Hashimoto et al teach preparation of solutions in a concentrate format in anticipation of Applicant's claimed solutions or methods of use.

Also for the record, reference to Applicant's compositions as "solutions" finds ample support in the application as originally filed. Example 3 on page 8 of the subject application refers to the developer compositions as "solutions". Page 5, line 10 also refers to the compositions as solutions. Also see original claim 12.

In Example 1 (Col. 37), Hashimoto et al demonstrate the benefits of their slurried concentrates with photographic agents in particulate form. In the color developer replenisher concentrate appearing in column 37, a total of 11 slurry concentrates were prepared each containing SEHA with a developer other than CD-4. Sample slurry Nos. 1 to 10 each contained a water-soluble polymer listed in Table 1 in column 55, at various levels, some inside and some outside the taught range.

Sample No. 11, however, served as the control and contained no water soluble polymer. Nevertheless, all 11 replenisher

compositions prepared by Hashimoto et al, including the control contained at least one of the photographic processing agents in particulate form, and each prepared as a dispersion (or slurry)concentrate (1000 ml)..see column 37, line 66. And, not as solution concentrates.

In testing for solubility of the slurries prepared (see col. 38) in best mode Example 1, the slurries of Hashimoto et al were dissolved by diluting with water to five (5) liters. The solutions prepared were working strength solutions, and not concentrates. The ready-to-use solutions are shown at the bottom of col. 38 and the top of column 39.

The test results for Example 1 are presented at column 55 of Hashimoto et al.

The bottom paragraph on page 4 of the Official Action in discussing the rejection of the claims over Hashimoto et al under Section 102(b) concludes the color developers of Hashimoto et al have at least **"satisfactory color development performance"** in referencing the language appearing in the claims of the instant application. Applicant courteously disagrees with this conclusion, which is unsupported by this reference.

In this regard, Applicant defines "satisfactory developer performance", as appearing in the claims, at page 3 of the specification to mean: complete and balanced development of the full color dye image, etc.

Hashimoto et al are not concerned with achieving or demonstrating ---complete and balanced development of the full color dye image--- as best illustrated by Hashimoto et al's working Examples 1 and 2. In Example 1, beginning at col. 37, Hashimoto et al made 10 Test Samples according to their invention (the 11th. was a control) which they tested. The test results are shown in Col. 55, wherein they tested the flow properties for residual material remaining in the container after emptying. However, in testing for

developer performance as shown in the bottom table in Col. 55, the patentees tested for  $D_{\max}$  only. More specifically, at the end of processing (developing), Hashimoto et al measured their images for  $D_{\max}$  of cyan, magenta and yellow using a densitometer and expressed the results as percent relative to  $D_{\max}$  for the "original" type (polymer-free) developer.

As discussed above in connection with the first ground of rejection under 35 U.S.C. 112, second paragraph,  $D_{\max}$  is the area of the "Control Strip" having the maximum density due to greatest exposure to light, so it appears as the darkest patch on the Strip. Hashimoto et al were seeking to match developer performance at one level only, namely  $D_{\max}$ , of cyan, magenta and yellow, whereas Applicant's developer solutions definitionally ("satisfactory developer performance") set performance across the full range of development ( $D_{\min}$ , LD, HD-LD and  $D_{\max}$ ). Also see the Applicant's Affidavit under 37 CFR 1.132.

Similarly, Hashimoto et al conducted other comparative studies of their slurry concentrates as demonstrated by best mode working Example 2, beginning at Col. 56. Column 83 reports the flow properties of their slurries, plus maximum density ( $D_{\max}$ ) only for developer performance.

Applicant submits, the slurry concentrates of Hashimoto et al were not tested for complete and balanced development i.e. for "satisfactory developer performance", contrary to the conclusion of the Official Action relative to this reference. As pointed out, Hashimoto et al failed to provide densitometer readings for areas of the Control Strips for  $D_{\min}$  (minimum density), LD (low density) or HD (high density). Such areas were apparently not tested, or if tested never reported.

Consequently, the conclusion of the Official Action that the compositions of Hashimoto et al have at least "satisfactory color performance" is unsubstantiated. Furthermore, the limited testing

of  $D_{\max}$  only of Hashimoto et al contradicts the Examiner's conclusion this reference is teaching at least "satisfactory developer performance", i.e., complete and balanced development in accordance with Applicant's definition at page 3.

The top paragraph of page 5 of the Official Action incorrectly postulates that the compositions of Hashimoto et al have the same ingredients as disclosed by Applicant's specification and are used for the same purposes. The Office Action concludes: the compositions of Hashimoto et al would inherently have the same properties as recited by the instant claims. Apparently, this includes "satisfactory developer performance."

In this regard, a proper inherency rejection can only exist when a reference teaches the same claimed invention. Applicant has pointed out in considerable detail above, the concentrates of Hashimoto et al are not solutions, but instead are slurries, which are dispersions containing solid, undissolved particles suspended in water with soluble polymeric material. Applicant's claimed invention relates to concentrate solutions. These are compositions possessing different properties than slurries/dispersions of Hashimoto et al.

Consequently, the slurry concentrates of Hashimoto et al, are not anticipatory within the meaning of 35 U.S.C. 102, as the Office Action concludes. On this basis, the Examiner urging the compositions of Hashimoto et al would inherently possess the same properties of those of Applicant's is without proper basis.

In sum, the conclusion the slurried compositions of Hashimoto et al inherently possess the same properties of Applicant's claimed solutions is prefaced more on conjecture and speculation, rather than fact.

To further substantiate the conclusion that Hashimoto et al is not a full anticipation of the claimed compositions, Applicant wishes to also highlight the fact that Hashimoto et al were also

applied in rejecting the same claims for reasons of obviousness under 35 U.S.C. 103(a) in paragraph 3 on page 5 of the Office Action. Seemingly, the Examiner also has at least some doubt concerning the merits of the rejection of claims 1-2, 5, 7, 11, 16, 18 and 19 under 35 U.S.C. 102, as being fully met by Hashimoto et al, by also rejecting the same claims for reasons of obviousness. By also rejecting the same claims on grounds of obviousness, the Examiner is at least tacitly acknowledging the novelty of the claims under 35 U.S.C. 102. Thus, the Official Action urging the slurried developer concentrates of Hashimoto et al inherently possess the same properties as Applicant's claimed solutions is without factual basis.

In view of the amendments to the claims and foregoing remarks rejected claims 1-2, 5, 7, 16 and 18-19 are clearly novel and patentably distinct over the disclosures of Hashimoto et al. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. 102(b) over Hashimoto et al are respectfully requested.

At page 5 of the Official Action, claims 1-5, 7, 11, 16, 18 and 19 were rejected under 35 U.S.C. 103(a) for reasons of obviousness over Hashimoto et al. This ground of rejection is courteously traversed as it applies to the claims now presented for re-examination.

On the question of obviousness, page 5 of the Official Action identifies SEHA, an acronym for N,N-bis(2-sulfoethyl)hydroxylamine, as compound 11 of Hashimoto et al. Applicant courteously points out that H-11 of Hashimoto et al is N,N-bis-ethyl-hydroxylamine. Compound H-11 lacks sulfonic acid groups, and cannot be correctly referred to as "SEHA."

With respect to the question of obviousness of the claims in view of Hashimoto et al, once again applicant courteously points to the fact that this reference is not concerned with the preparation of solution concentrates. As previously mentioned, Hashimoto et al

is concerned with slurries (or dispersions) prepared with a polymer additive wherein at least one ingredient is in particulate form.

Importantly also, from a fair reading of Hashimoto et al, there is no reasonable expectation that modification of their compositions so they are no longer slurries, i.e., prepared as solution concentrates, that as solutions they will still provide the results desired by Hashimoto et al.

In this connection, obviousness under Section 103 cannot properly be predicated on the disclosures of a reference to arrive at the claimed invention in the absence some teaching or suggestion in the reference.

Applicant wishes to highlight the fact that the only solutions prepared by Hashimoto et al are working strength solutions when testing developer performance.

The Official Action at paragraph 3 on page 5 highlights Example 2 of Hashimoto et al, which allegedly shows CD-4 developer in combination with hydroxylamine H-11. In this regard, Example 2 (columns 56-57) of Hashimoto et al shows a dry combination of ingredients in the formulation at the top of column 57. This is not a solution. According to Example 2, the dry mixture was pulverized in a kneader, and various polymers added to the mixture (See Table 3) with some water in order to form pastes (not solution concentrates). The pastes were gradually diluted with water to form, once again, uniform slurries. Water soluble polymer was omitted in Sample No. 31, which was used as a control, however, in all instances the concentrates were prepared as slurries, including control Sample No. 31.

The reason was: a key objective of Hashimoto et al was to demonstrate that water soluble polymer additive would enhance the discharge of slurry concentrates from storage containers into photographic processors where they are diluted down with water to form working strength solutions. The data table in column 83 of



Hashimoto et al shows high residues of slurry composition remaining in the containers for Sample Nos. 27 through 31, and particularly high levels of materials remaining in those containers after storage. **Sample No. 31 (control) had 256.8 grams of residual material remaining in the container after discharge. This demonstrated a lack of fluidity of the slurry concentrate in the absence of polymer additive.** Hence, Hashimoto et al had demonstrated the importance of polymer additive for enhancing flow properties of slurried compositions.

As pointed out above in connection with the rejection of the claims under 35 U.S.C. 102(b) over Hashimoto et al, this reference tested the performance of their slurry developer concentrates. However, there is nothing in this reference to suggest the compositions provided "complete and balanced development of the full color image....." in anticipation of Applicant's "satisfactory developer performance". As previously discussed, Hashimoto et al tested and provided data for maximum density or  $D_{max}$  only. Hashimoto et al failed to provide densitometric readings for areas of the Control Strips for  $D_{min}$  (minimum density), LD (low density) or HD (high density). Such areas were apparently not tested, or if tested never reported.

In either case, Hashimoto et al would not render Applicant's claims obvious within the meaning of 35 U.S.C. 103(a) because the reference fails to teach or suggest all the elements of Applicant's claims. In sum, Hashimoto et al fail to teach or suggest developer concentrate solutions which also meet the requirements for "satisfactory developer performance."

In view of the amendments to the claims and the foregoing discussion of the reference, reconsideration and withdrawal of the rejection on grounds of obviousness of claims 1-5, 7, 11, 16, 18 and 19, are courteously requested.

At page 6, paragraph 4., of the Official Action, claims 1-2,

5-9, 12-13 and 15-19 were rejected under 35 U.S.C. 102(e) as being anticipated by Tappe et al '703. This ground of rejection is courteously traversed.

Tappe et al disclose developer concentrate solutions which are capable of remaining stable in solution during storage, and without precipitation. According to the disclosure of Tappe et al, for the developer, either CD-3 or CD-4, to remain as a stable concentrate and not precipitate out of solution during storage, the developer must not be added as the sulfate salt, but may only be added as a phosphate salt, p-toluenesulfonate salt, chloride salt or be used as a free base. Furthermore, the developer solution **must be a multi-phase system**. That is, the solution must contain two (2) or more liquid phases to remain stable and avoid precipitation.

A monophasic solution, according to the disclosure of Tappe et al, is unstable, and constituents will precipitate out of solution during storage.

Accordingly, Tappe et al disclose and claim a one-part solution developer concentrate, but with multiple solution-phases that are free of CD-4 sulfate developer, contains at least one antioxidant, at least one water softener, a buffer system, alkali and a water soluble organic solvent. In contradistinction, Applicant's developer concentrate solutions are storage stable whether prepared as monophasic solutions or as multiphasic solutions, i.e., having two or more liquid phases. Claim 1 has been further amended to expressly provide for either monophasic or multiphasic system. This new limitation is disclosed at the top of page 3 of the instant application; page 5, lines 21-25 of the specification and page 6, lines 13-19. Accordingly, claim 1 and claims dependent therefrom are patentably distinct and mutually exclusive from the disclosures of Tappe et al. As clearly disclosed and claimed, Applicant's one-part developer solution concentrates are storage stable whether prepared in a monophasic liquid format, or multiphasic.

liquid format. This is a significant improvement over the solutions of Tappe et al.

Applicant, Laszlo Papai, is also furnishing herewith a Declaration under 37 CFR 1.131, showing completion of his invention in the United States prior to September 11, 2000, the US filing date of Tappe et al. Tappe et al was cited under 35 U.S.C. 102(e). That is, the rejection is not based on the citation of prior art constituting a statutory bar under 35 U.S.C. 102(b).

While the claims of Tappe et al recite CD-4 developer, the claims fail to recite N,N-bis(2-sulfoethyl)hydroxylamine (SEHA) antioxidant. **Only claim 6 of Tappe et al recites hydroxylamine type antioxidants.** However, the hydroxylamine antioxidant species of claim 6 of Tappe et al fail to include any bis-sulfoalkyl species or SEHA, nor does Tappe et al recognize the importance of SEHA in combination with CD-4 developer in achieving "satisfactory developer performance", according to the express language of Applicant's claims. Finally, Tappe et al's claimed invention relating to storage stability is clearly dependent on two or more liquid phases, whereas Applicant's claimed one-part developer solution concentrates remain storage stable whether in a monophasic or multiphase system. Hence, the disclosure of Tappe et al while applied in rejecting the claims of the subject-Application, Tappe et al is not claiming the same invention as that of Applicant.

The Rule 131 Affidavit by the inventor, Laszlo Papai, provides documentary evidence of first a conception of a one (1) part developer concentrate solution comprising CD-4 developer and SEHA as a hydroxylamine antioxidant, prepared from three (3) solutions which are combined into the developer concentrate. The 131 Affidavit also demonstrates actual reduction to practice of the conceived C-41 Triphase Developer concentrate. The solutions were then tested for stability. They were also evaluated for developer performance according to the stated criteria for satisfactory

developer performance for complete and balanced development of the full color image to industry-norm statistical standards as measured by densitometric (sensitometric) readings of processed control strips.

Conception and reduction to practice, including demonstrating utility in the US were completed at a date prior to September 11, 2000, the effective date of Tappe et al as a reference under 35 U.S.C. 102(e).

Accordingly, for reasons outlined above distinguishing Applicant's invention over that of Tappe et al, the claims as amended, and the inventor's Affidavit under 37 CFR 1.131, the rejection of claims 1-2, 5-9, 12-13 and 15-19 should be withdrawn.

At page 7 of the Official Action of September 3, 2003, claims 1-19 were rejected under 35 U.S.C. 103(a) as unpatentable over a combination of seven (7) references: Darmon et al '687 and Papai in view of Burns et al and Hashimoto et al, further in view of Ishikawa '930, Ishikawa et al '520 and Marrese et al. This ground of rejection is respectfully traversed.

Darmon et al ('687) discloses developer replenisher concentrates with developing agent, antioxidant, etc. Darmon et al mention the developer can be CD-4, but also mentions equally CD-2 and CD-3 developers among preferred developing agents. Darmon et al also mention the use of one or more developer antioxidants. Several classes of antioxidants are suggested by Darmon et al, including, but not limited to sulfites, hydrazines, hydrazides, amino acids, hydroxamic acids, hydroxylamines, aminoketones, polysaccharides, and so on. Darmon et al mention hydroxylamine derivatives, including sulfo, carboxy, amino, sulfonamido, carbonamido and hydroxy derivatives of hydroxylamine antioxidants, but fail to teach SEHA, specifically. One best mode working example at column 10 pairs CD-3 developer (not CD-4) with diethylhydroxylamine.

Importantly, Darmon et al do not teach or suggest Applicant's

specific combination of SEHA or N,N-bis(2-sulfoethyl)hydroxylamine with CD-4 developer in solution for purposes of stabilizing an otherwise highly unstable developer, and simultaneously achieve a level of color developer performance, namely "complete and balanced development of the full color image.....", for "satisfactory developer performance."

While Hashimoto et al, cited with Darmon et al, disclose the combination of SEHA and CD-4 as one of several possible combinations, the replenishers of Hashimoto et al are slurries. In this regard, Darmon et al, at col. 2, lines 50-60 are clearly critical of one-part developer slurry concentrates, like those of Hashimoto et al.

Darmon et al expressly teach:

"Some color developing compositions are commercially available in single-part formulations that overcome some of the noted problems, but because of the presence of precipitates (such as slurries) or multiple solvent phases, they require vigorous agitation or mixing before use. Such compositions are generally limited to small volumes. In addition, the presence of the precipitates or "sludge" may be unattractive to users, and some users may not have suitable equipment for proper agitation for multi-phase compositions." (Emphasis added)

It is apparent, Darmon et al is concerned with color developer solution concentrates, and in view of the negative teachings relative to slurried concentrates, persons skilled in the art would not combine the teachings of Hashimoto et al with those of Darmon et al, as urged at page 8 of the Official Action. More accurately, Darmon et al in identifying shortcomings in connection with slurried developer concentrates is teaching away from the compositions of the type disclosed by Hashimoto et al.

While Burns et al '327 has been cited as disclosing SEHA, this adds little, if anything, insofar as reinforcing the conclusion of obviousness when taken with Darmon et al. In fact,

Burns et al teach methods for preparing an extensive and comprehensive range of hydroxylamine derivatives used in photo processing solutions. It is significant that Burns et al do not suggest any specific hydroxylamine as especially desirable with any particular developer. The major thrust of Burns et al resides in the discovery of a novel method for making hydroxylamine derivatives that allows their usage of the reaction mixture without having to isolate the hydroxylamine derivative from other by-products of the reaction.

Importantly, the rejection appears to be heavily based on prohibited hindsight reconstruction where the invention became obvious only after a prior reading of Applicant's own disclosure because neither Burns et al, nor Darmon et al teach or even remotely suggest the use of SEHA as the antioxidant of choice with CD-4 developer solution concentrates to achieve both good shelf-life stability for an otherwise highly unstable developer, but also "complete and balanced development of the full color image....." for "satisfactory developer performance."

As discussed above, Hashimoto et al disclose in one example CD-4 developer and SEHA formulated first into a paste, and then into a slurried concentrate with water soluble polymers for improved flow properties. Hashimoto et al was apparently not interested in Applicant's claimed "complete and balanced development of the full color image....." i.e., "satisfactory developer performance" as demonstrated by providing data for  $D_{max}$  only, not for the full color image. In any event, Darmon et al is clearly negative on slurried developer concentrates, and accordingly, **teach away** from such compositions.

The Papai reference (US Pat. 5,891,609), also applied in rejecting the instant claims, does not offset the several shortcomings identified above in connection with this rejection on the ground of obviousness, under 35 U.S.C. 103(a). Papai suggest

inorganic antioxidants in col. 5, lines 43 et. seq., e.g., sodium sulfite. Col. 9, lines 3-14 mention organic hydroxylamines, with the preferred specie being diethylhydroxylamine. SEHA is neither specifically taught nor suggested by Papai.

It is also noteworthy, Darmon et al was also quite critical of multiphase type concentrates like those taught by Papai. Hence, this is further mitigating evidence against the combination of seven references cited in support of the conclusion of obviousness.

Ishikawa et al '520 and Ishikawa '930 were also cited in this obviousness rejection as allegedly standing for the proposition that SEHA is a preferred hydroxylamine antioxidant. However, the processing agents employed by Ishikawa et al '520 are "thick replenishers" which are diluted with varying amounts of water by the developing apparatus during processing the film. In each case, the replenisher supplied to the processing machine starts as a "thick replenisher" containing solid processing agents. The replenishers appear to be a "paste", and not a solution.

Ishikawa et al '520 teach tank solutions or replenishers which may contain hydroxylamine derivatives.

Once again, Applicant refers to his accompanying Affidavit under 37 CFR 1.131 which also swears back of both Ishikawa et al '520 and Ishikawa '930. More specifically, Applicant's Affidavit demonstrates completion of his invention in the US through conception and actual reduction to practice prior to May 16, 2000, the date under 35 U.S.C. 102(e) Ishikawa '930 was filed in the US. Applicant's Affidavit under Rule 131 also demonstrates completion of his invention in the US prior to July 28, 1998, the effective US filing date of Ishikawa et al '520 under Section 102(e).

Accordingly, Applicant maintains both Ishikawa references ('520 and '930) are effectively removed from this ground of rejection under 35 U.S.C. 103(a).

Marrese et al was also cited with six (6) other references to allegedly suggest the use of SEHA. In this regard, the Office

Action highlighted col. 1 which mentions sulfonyl groups in hydroxylamine antioxidants for reduction of the odor problem caused by the release of amines. In response thereto, Applicant points out: this is a non-enabling teaching by Marrese et al. There are several known sulfonyl-containing hydroxylamine compounds known and used as antioxidants in photographic processing solutions, but Marrese et al fail to mention which specific sulfonyl antioxidant would provide the desired response.

In this regard, Applicant courteously directs the Examiner's attention to Hashimoto et al, also cited in support of this rejection under Section 103. Columns 20 and 21 of Hashimoto et al list no fewer than six (6) possible hydroxylamine antioxidants containing sulfonyl groups, namely H7, H8, H13, H16, H18 and H20. Marrese et al provide no information which of the above six possible sulfonyl-containing hydroxylamine derivatives should be used with CD-4 developer to achieve stability with such an unstable compound (developer).

While the Office Action is relying on Marrese et al to suggest this reference is referring **only to SEHA** as the antioxidant of choice, the fact remains that Marrese et al fail to specifically teach SEHA as the sole sulfonyl-containing hydroxylamine derivative, when in fact Hashimoto et al teach at least six possible candidates. Accordingly, Marrese et al is non-enabling with respect to the specific selection of SEHA, or any other possible sulfonyl-antioxidant derivative. Hence, Marrese et al cited in support of this obviousness rejection is nothing more than an invitation to engage in experimental trial and error research.

The Official Action at pages 10 and 11 urges the comparative data in Applicant's specification is deemed unconvincing of **unexpected results, etc.** The closing statements appearing at pages 10-11 relative to the need to show unexpected results presuppose this last rejection of the claims has made out a *prima facie* case



of obviousness causing the burden of proof to shift to Applicant to present evidence of nonobviousness, e.g., surprising/unexpected results.

In this connection, a strenuous and sincere effort has been made to point out the significant shortcomings in a rejection which has relied on seven (7) references. A rejection based on stringing together such a significant number of patents to make out a *prima facie* case of obviousness is likely probative evidence of non-obviousness. Obviousness under 35 U.S.C. 103 may not be predicated on "picking and choosing" elements of Applicant's claimed invention by resorting to multiple patents and selecting only those elements which support the Examiner's position to the exclusion of other elements of the references, which may be non-pertinent. The rejection under Section 103 is heavily laden with hindsight. How else could one string so many patents together to arrive at a conclusion of obviousness. This rejection could not have been arrived at independently of Applicant's own application, and the benefit of a prior reading by the Examiner. In sum, the rejection under 35 U.S.C. 103(a) does not require Applicant to make a showing of surprising or unexpected results, as suggested by the Official Action.

Finally, both Ishikawa patents have been effectively removed from this rejection. Marrese et al, Burns et al, including Papai add nothing to suggest any particular hydroxylamine derivative as being especially favorable for stabilizing developer concentrate solutions containing such an unstable developing agent, like CD-4. Hashimoto et al relate to slurry concentrates, which the primary reference to Darmon et al teaches away from.

Accordingly, the combination of seven (7) patents has not made out a *prima facie* case of obviousness. Reconsideration and withdrawal of the rejection of claims 1-19 under 35 U.S.C. 103(a) are courteously solicited.

## CONCLUSIONS

1.) It has been shown that the meaning of the expression "satisfactory developer performance" is not indefinite, and therefore, not in violation of the second paragraph of 35 U.S.C. 112. The Affidavit under 37 CFR 1.132 by the Applicant, Laszlo Papai, with the attached **EXHIBIT** provides good convincing evidence that the meaning of "satisfactory developer performance" is both well known and widely used among persons of ordinary skill in the photo imaging art. The expression denotes a real process that enables measuring on a comparative basis the density, color and contrast of color negatives to an industry norm;

2.) A detailed and comprehensive analysis of the Hashimoto et al reference has been presented showing the slurries and the performance of the compositions as developer concentrates fail to meet the criteria (limitations) of Applicant's claims either on grounds of lack of novelty (102), or for reasons of obviousness (103);

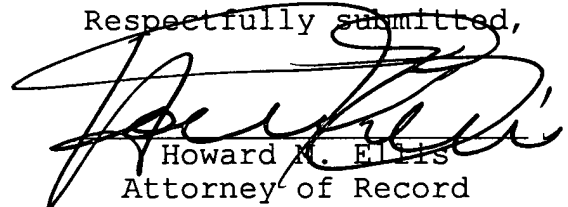
3.) Tappe et al, has been effectively removed as a reference through the inventors affidavit under Rule 131 with EXHIBITS demonstrating completion of the invention at a date prior to the effective filing date of the reference, and so the rejection cannot be maintained. However, even in the absence of the Rule 131 Affidavit it has been shown that applicant's invention is patentably distinct over Tappe et al. Applicant's improved solution concentrates are suitable as both monophasic and multiphase solutions, as expressly claimed, and

4.) The rejection of the claims for reasons of obviousness over seven (7) references cannot stand, i.e., the rejection of claims 1-19 under 35 U.S.C. 103(a) over Darmon et al '687 and Papai in view of Burns et al and Hashimoto et al, further in view of Ishikawa '930, Ishikawa et al '520 and Marrese et al. A thicket of patents has been assembled based on a high reliance on prohibited

hindsight reconstruction from a prior reading of Applicant's own disclosure. A *prima facie* case of obviousness has not been made out. This is reinforced by Applicant's Affidavit under Rule 131 swearing back of both Ishikawa patents.

In view of the amendments to the claims, the accompanying Affidavits under 37 CFR 1.131 and 37 CFR 1.132, and the foregoing remarks distinguishing over the references of record, this application is now in condition for allowance. Notification of the same at an early date is courteously solicited.

Respectfully submitted,



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